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10/748,449

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Richard D. Keeven

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MAGINOT, MOORE & BECK, LLP

CHASE TOWER

111 MONUMENT CIRCLE

SUITE 3250

INDIANAPOLIS, IN 46204

EXAMINER

WOODALL, NICHOLAS W

ART UNIT

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3733

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,449	<b>Applicant(s)</b> KEEVEN ET AL.	
	<b>Examiner</b> Nicholas Woodall	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 26 and 30 are objected to because of the following informalities: Claims 26 and 30 are directed to a method and not the system. For examination purposes, the examiner will interpret that claims as being directed to the system. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Kaufman (U.S. Patent 4,721,104).

Kaufman discloses a device comprising an instrument, an augment (5), and a femoral resection guide (60). The instrument includes a positioning member (61) defining a femur facing side and a tibia facing side. The positioning member includes a first coupler (65) and a connector member comprising a first mating feature (a bore receiving or created by screw 62 column 5 lines 1-7). The augment includes a second coupler (92) that cooperates with the first coupler to fix the augment to the positioning member. The femoral resection guide includes a second mating feature (62) that mates with the first mating feature.

Art Unit: 3733

4. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by LaSalle (U.S. Patent 5,976,147).

LaSalle discloses a device comprising an instrument, an augment (20), and a resection guide (12) capable of being used on a femur. The instrument includes a positioning member (18) including a first coupler (90) and a connector member (16) including a first mating feature (60). The augment includes a second coupler (124) that cooperates with the first coupled to fix the augment to the positioning member. The resection guide includes a second mating feature (58) that mates with the first mating feature.

5. Claims 28 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by LaSalle (U.S. Patent 5,976,147) as a second interpretation different from the interpretation discussed above.

LaSalle discloses a device comprising an instrument (12 and 18), an augment (20), and an intramedullary pin (16). The instrument includes a positioning member (18) that defines a femur facing side and a tibia facing side, wherein the instrument includes a first coupler (90), a guide slot (58) that receives the intramedullary pin, and a handle extending from the positioning member (column 6 lines 33-36). The augment includes a second coupler (124) that cooperates with the first coupler to fix the augment to the positioning member.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3733

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Kaufman (U.S. Patent 4,721,104).

Kaufman discloses the invention as claimed except for the first coupler being a bore and the second coupler being a pin received within the bore. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Kaufman wherein the first coupler is a bore and the second coupler is a pin received within the bore, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

8. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman (U.S. Patent 4,721,104) in view of Vito (U.S. Patent 5,931,838).

Kaufman discloses the invention as claimed except for the first coupler including a bore and the second coupler being a pin received within the bore and the bore defining an internal groove receiving an o-ring that engages the pin. Vito teaches a device comprising a first coupler (27) defining an internal groove (28) that includes a resilient o-ring (30) and a second coupler (40) that engages the o-ring in order to lock the two elements together. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Kaufman wherein the first coupler is a bore and the second coupler is a pin received within the bore, since it has been held that a mere reversal of the essential working parts of a device involves

Art Unit: 3733

only routine skill in the art. In re Einstein, 8 USPQ 167. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Kaufman wherein the first coupler further includes an internal groove receiving a resilient o-ring that engages the second coupler in view of Vito in order to lock the two elements together.

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaSalle (U.S. Patent 5,976,147) as the first interpretation discussed above.

LaSalle discloses the invention as claimed except for the first coupler being a bore and the second coupler being a pin received within the bore. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of LaSalle wherein the first coupler is a bore and the second coupler is a pin received within the bore, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

10. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaSalle (U.S. Patent 5,976,147) as the first interpretation discussed above in view of Vito (U.S. Patent 5,931,838).

LaSalle discloses the invention as claimed except for the first coupler including a bore and the second coupler being a pin received within the bore and the bore defining an internal groove receiving an o-ring that engages the pin. Vito teaches a device comprising a first coupler (27) defining an internal groove (28) that includes a resilient o-ring (30) and a second coupler (40) that engages the o-ring in order to lock the two

Art Unit: 3733

elements together. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of LaSalle wherein the first coupler is a bore and the second coupler is a pin received within the bore, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of LaSalle wherein the first coupler further includes an internal groove receiving a resilient o-ring that engages the second coupler in view of Vito in order to lock the two elements together.

11. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaSalle (U.S. Patent 5,976,147) as the second interpretation discussed above.

LaSalle discloses the invention as claimed except for the first coupler being a bore and the second coupler being a pin received within the bore. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of LaSalle wherein the first coupler is a bore and the second coupler is a pin received within the bore, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

12. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaSalle (U.S. Patent 5,976,147) as the second interpretation discussed above in view of Vito (U.S. Patent 5,931,838).

LaSalle discloses the invention as claimed except for the first coupler including a bore and the second coupler being a pin received within the bore and the bore defining an internal groove receiving an o-ring that engages the pin. Vito teaches a device comprising a first coupler (27) defining an internal groove (28) that includes a resilient o-ring (30) and a second coupler (40) that engages the o-ring in order to lock the two elements together. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of LaSalle wherein the first coupler is a bore and the second coupler is a pin received within the bore, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of LaSalle wherein the first coupler further includes an internal groove receiving a resilient o-ring that engages the second coupler in view of Vito in order to lock the two elements together.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..



Art Unit: 3733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733  
/Frederick R Schmidt/  
Director, Technology Center